Pending Claims

5.   A method of controlling a receiver station, said receiver station including a receiver, a memory operatively connected to said receiver, and at least one processor operatively connected to said memory, said method comprising the steps of:

receiving an information transmission containing processor instructions and a program;

programming said receiver station to perform a predetermined secondary error correction routine in accordance with said processor instructions;

performing a primary error correction routine by processing at least a portion of said information transmission;

passing information contained in said program to said memory;

discerning a failure evidencing one of an incomplete and an incorrect program element in said memory by reprocessing information received in said information transmission; and

executing said predetermined secondary error correction routine in consequence of said step of discerning a failure;

wherein said method controls said receiver station.

6.   The method of claim 5, wherein one of said primary error correction routine and said secondary error correction routine comprises the step of:

clearing at least a portion of said memory.

7.   The method of claim 5, further comprising the step of:

one of placingand replacing data at said memory to one of complete and correct a program element in consequence of said step of executing a predetermined secondary error correction routine.

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8.   The method of claim 5, further comprising the step of:

interrupting a processor in accordance with one of said primary error correction

routine and said secondary error correction routine.

9.   The method of claim 5, further comprising the steps of:

selecting a value designating an instruction to be executed; and

jumping to a memory location based on said selected value.

10.   The method of claim 5, wherein said step of selecting a value comprises

computing at least some an address of said memory location.

11.   The method of claim 5, further comprising the steps of:

storing history-of-efficiency information; and

performing one of the functions of instituting and restoring functionality of said

at least one processor based on said stored history of efficiency information.

12.   The method of claim 5, wherein said step of discerning a failure comprises

comparing information stored at a first memory location to information stored at a

second memory location.

13.   The method of claim 5, wherein at least one of said first memory location

and said second memory location is a dedicated register at said at least one processor.

14.   The method of claim 5, wherein said primary error correction routine

includes forward error correction and said step of discerning a failure is based on

information processed in said step of performing primary error correction.

15. The method of claim 5, wherein said one of said incomplete and said incorrect program element in said memory is one of (1) one of an incomplete and an incorrect element of said received program, and (2) at least a portion of a second program.

16. The method of claim 5, further comprising the step of:

performing forward error correction information to be one of outputted in and outputted with said program before performing said steps of (1) performing a primary error correction routine and (2) discerning a failure.

17. The method of claim 5, wherein said step of performing a primary error correction routine further comprises:

selecting program material to be one of outputted and not outputted at said receiver station.

18. The method of claim 5, further comprising selecting program material to be one of outputted and not outputted at said receiver station in accordance with said second error correction routine.

19. The method of claim 5, wherein said program includes at least one of a television program, a radio program, a computer program, and some of a combined medium program.

20. The method of claim 19, further comprising the step of:

selecting at least one of a program instruction set, intermediate generation set, combining synchronizing command, and data to be processed to present combined medium programming.

21.   The method of claim 20, further comprising the step of:

programming said receiver station with at least a portion of said primary error correction routine and said secondary error correction routine.

22.   The method of claim 21, wherein said step of programming said receiver station comprises:

receiving said at least a portion of said primary error correction routine and said secondary error correction routine from a remote station;

directing said received at least a portion of said primary error correction routine and said secondary error correction routine from said remote station to at least one of a register and a re-programmable memory operatively connected to said at least one processor; and

storing said at least some of said primary error correction routine and said secondary error correction routine at said at least one of a register and a re-programmable memory operatively connected to said at least one processor.

23.   A method of controlling a receiver station, said receiver station including a receiver, a memory operatively connected to said receiver, and at least one processor operatively connected to said memory, comprising the steps of:

receiving an information transmission at a transmission station, said information transmission containing only a portion of processor instruction and a program;

generating the remainder of said processor instructions and said program; and

transmitting said information transmission containing said program and said processor instructions, wherein said processor instructions program said receiver

station to perform a predetermined secondary error correction routine in accordance with said processor instructions, wherein said program enables said receiver station to perform a primary error correction routine by processing at least a portion of said information transmission, discerning a failure evidencing one of an incomplete and an incorrect program element by reprocessing information received in said information transmission, and executing a predetermined secondary error correction routine in consequence of discerning a failure.

24.   A method of controlling a receiver station, said receiver station including a receiver, a memory operatively connected to said receiver, and at least one processor operatively connected to said memory, comprising the steps of:

receiving an information transmission to be transmitted;

receiving an instruct signal which one of:

(a)   effects a transmission station to generate a program, said receiver station to perform a primary error correction routine by processing at least a portion of said information transmission, discerning a failure evidencing one of an incomplete and an incorrect program element by reprocessing information received in said information transmission, and executing a predetermined secondary error correction routine in consequence of discerning a failure; and

(b)   effects a receiver station to generate a program, said receiver station to perform a primary error correction routine by processing at least a portion of said information transmission, discerning a failure evidencing one of an incomplete and an incorrect program element by reprocessing information received in said information transmission, and executing a predetermined secondary error correction routine in consequence of discerning a failure;

receiving a transmitter control signal which operates at said transmitter station to communicate said program to a transmitter; and

transmitting said information transmission, said instruct signal and said transmitter control signal.

25.   A method of controlling a receiver station, said receiver station including a receiver, a memory operatively connected to said receiver, and at least one processor operatively connected to said memory, said method comprising the steps of:

receiving an information transmission containing mass medium programming including audio programming;

performing a primary error correction routine by processing at least a portion of said information transmission;

passing information contained in said mass medium programming to said memory;

discerning a failure evidencing one of an incomplete and an incorrect mass medium programming element in said memory by reprocessing information received in said information transmission; and

executing a predetermined secondary error correction routine in consequence of said step of discerning a failure;

wherein said method controls said receiver station.

26.   The method of controlling a receiver station of claim 25, wherein said step of executing a predetermined secondary error correction routine further includes the step of:

at least one of completing, correcting and discarding at least a portion of said mass medium programming including said audio programming.

27.   A method of controlling a receiver station, said receiver station including a receiver, a memory operatively connected to said receiver, and at least one processor operatively connected to said memory, said method comprising the steps of:

receiving an information transmission containing computer programming which programs said receiver station;

performing a primary error correction routine by processing at least a portion of said computer programming;

passing information contained in said computer programming to said memory;

discerning a failure evidencing one of an incomplete and an incorrect program element in said memory by reprocessing said computer programming received in said information transmission; and

executing a predetermined secondary error correction routine in accordance with said received computer programming;

wherein said method controls said receiver station.

28.   A method of controlling a receiver station, said receiver station including a receiver, a memory operatively connected to said receiver, and at least one processor operatively connected to said memory, said method comprising the steps of:

receiving an information transmission containing a program;

performing a primary error correction routine by processing at least a portion of said information transmission;

passing information contained in said program to said memory;

discerning a failure evidencing one of an incomplete and an incorrect program element in said memory by reprocessing information received in said information transmission;

selecting one of a plurality of predetermined secondary error correction routines to execute in consequence of said step of discerning a failure; and

executing said selected one of said plurality of predetermined secondary error correction routines;

wherein said method controls said receiver station.

29.   A method of controlling a receiver station, said receiver station including a receiver, a memory operatively connected to said receiver, and at least one processor operatively connected to said memory, said method comprising the steps of:

receiving an information transmission containing a program;

performing a primary error correction routine by processing at least a portion of said information transmission;

passing information contained in said program to said memory;

discerning a failure evidencing an incompletion of a function; and

executing a predetermined secondary error correction routine in consequence of said step of discerning a failure;

wherein said method controls said receiver station.

30.   A method of controlling a receiver station, said receiver station including a receiver, a memory operatively connected to said receiver, and at least one processor operatively connected to said memory, said method comprising the steps of:

receiving an information transmission containing processor instructions and a program;

programming said receiver station to perform at least one error correction routine in accordance with said processor instructions;

performing a primary error correction routine by processing at least a portion of said information transmission;

passing information contained in said program to said memory;

discerning a failure evidencing one of an incomplete and an incorrect program element in said memory by reprocessing information received in said information transmission; and

executing a secondary error correction routine in consequence of said step of discerning a failure;

wherein at least one of a said primary error correction routine and said secondary error correction routine is performed in accordance with said processor instructions and wherein said method controls said receiver station.

31.   The method of controlling a receiver station of claim 30, wherein said program is mass medium programming.

32.   The method of controlling a receiver station of claim 30, wherein said program is computer programming.

33.   The method of controlling a receiver station of claim 30, wherein the step of discerning a failure further comprises the step of:

reprocessing information received in said information transmission.

34.   A method of controlling a receiver station, said receiver station including a receiver, a memory operatively connected to said receiver, and at least one processor operatively connected to said memory, said method comprising the steps of:

receiving at least one information transmission containing processor instructions and a program;

programming said receiver station to perform at least one error correction routine in accordance with said processor instructions;

performing at least one primary error correction routine by processing at least one portion of said at least one information transmission;

passing information contained in said program to said memory;

discerning a failure evidencing one of an incomplete and an incorrect program element in said memory; and

executing a secondary error correction routine in consequence of said step of discerning a failure;

wherein at least one of a said primary error correction routine and said secondary error correction routine is performed in accordance with said processor instructions and wherein said method controls said receiver station.

II.   REMARKS

A.   Introduction

The Final Office Action dated December 31, 1995 (Final Office Action) has been carefully reviewed and the foregoing amendment made in response thereto.

Applicants have deleted a few lines from the specification for clarity. No new matter is added by this amendment.

Claims 5-34 are pending in the application.

Claims 5-34 are rejected under 35 U.S.C. § 112, first paragraph, as containing subject matter which was not described in the specification in such a way as to reasonably convey to one skilled in the relevant that the inventors, at the time the application was filed, had possession of the claimed invention.

The specification is objected to under 35 U.S.C. § 112, first paragraph, as failing to provide proper antecedent basis for the claimed subject matter.

Claims 5-21[1] and 23-34 are rejected under 35 U.S.C. § 103 (a) as being

unpatentable over DeLuca et al. (DeLuca), U.S. Pat. No. 4,835,777 in view of George et

al. (George), U.S. Pat. No. 4,495,623.

Additionally, the Final Office Action objects to the drawings as allegedly failing

to show all of the features recited in the claims.

Claims 5-34 remain active in this application. No new matter is presented in the

foregoing amendments. Approval and entry of same is respectfully requested.

B.   **Response to Requirement Imposed Upon Applicants to
      Resolve Alleged Conflicts Between Applicants'
      Applications.**

Applicants respectfully traverse the requirements of the Final Office Action

paragraph 18.

Paragraph 18 of the Final Office Action requires Applicants to either:

(1)   file terminal disclaimers in each of the related 328 applications terminally

disclaiming each of the other 327 applications; or

(2)   provide an affidavit attesting to the fact that all claims in the 328

applications have been reviewed by applicant and that no conflicting claims exist

between the applications; or

(3)   resolve all conflicts between claims in the related 328 applications by

identifying how all the claims in the instant application are distinct and separate

inventions from all the claims in the above identified 328 applications.

In addition, Examiner states that failure to comply with any one of these

requirements will result in abandonment of the application.

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[1] Although the Final Office Action recites that claims 5-12, 23, and 24-34 are rejected, it appears from the
discussion that claims 13-21 are also rejected. If claims 13-21 are not rejected, Applicants respectfully
request notification of allowability for these claims.

Examiner states that the requirement has been made because conflicts exist between claims of the related co-pending applications, including the present application. Examiner sets forth only the serial numbers of the co-pending applications without an indication of which claims are conflicting. Examiner has also attached an Appendix providing what is deemed to be clear evidence that conflicting claims exist between the 328 related co-pending applications and the present application. Further, Examiner states that an analysis of all claims in the 328 related co-pending applications would be an extreme burden on the Office requiring millions of claim comparisons.

Applicants respectfully traverse these requirements in that Examiner has both improperly imposed the requirements, and has incorrectly indicated that abandonment will occur upon failure to comply with the requirement. Applicants' traversal is supported by the fact that 37 C.F.R. § 1.78 (b) does not, under the present circumstances, provide Examiner with authority to require Applicants to either: 1) file terminal disclaimers; 2) file an affidavit; or 3) resolve all apparent conflicts. Additionally, the penalty of abandonment of the instant application for failure to comply with the aforementioned requirement is improper for being outside the legitimate authority to impose abandonment upon an application. The following remarks in Section (B) will explain Applicants' basis for this traversal.

1.   **The PTO's New Requirement is an Unlawfully Promulgated Substantive Rule Outside the Commissioner's Statutory Grant of Power**

The PTO Commissioner obtains his statutory rulemaking authority from the Congress through the provisions of Title 35 of the United States Code. The broadest grant of rulemaking authority -- 35 U.S.C. § 6 (a) -- permits the Commissioner to promulgate regulations directed only to "the conduct of proceedings in the [PTO]". This provision does <u>NOT</u> grant the Commissioner authority to issue substantive rules of patent law. <u>Animal Legal Defense Fund v. Quigg</u>, 932 F.2d 920, 930, 18 U.S.P.Q.2d

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1677, 1686 (Fed Cir. 1991).[2] Applicants respectfully submit that the Examiner's creation

of a new set of requirements based upon 37 CFR § 1.78(b) constitutes an unlawful

promulgation of a substantive rule in direct contradiction of a long-established

statutory and regulatory scheme.

2. The PTO's Requirement is a Substantive Rule

The first determination is whether the requirement as imposed by the PTO upon

Applicants is substantive or a procedural rule. The Administrative Procedure Act offers

general guidelines under which all administrative agencies must operate. A

fundamental premise of administrative law is that administrative agencies must act

solely within their statutory grant of power. *Chevron v. Natural Resources Defense

Council*, 467 U.S. 837 (1984). The PTO Commissioner has NOT been granted power to

promulgate substantive rules of patent law. *Merck & Co., Inc. v. Kessler*, 80 F.3d 1543

(Fed. Cir. 1996), citing, *Animal Legal Defense Fund v. Quigg*, 932 F.2d 920, 930, 18

U.S.P.Q.2d 1677, 1686 (Fed. Cir. 1991).

The appropriate test for such a determination is an assessment of the rule's

impact on the Applicant's rights and interests under the patent laws. *Fressola v.

Manbeck*, 36 U.S.P.Q.2d 1211, 1215 (D.D.C. 1995). As the PTO Commissioner has no

power to promulgate substantive rules, the Commissioner receives no deference in his

interpretation of the statutes and laws that give rise to the instant requirement. *Merck &

Co., Inc. v. Kessler*, 80 F.3d 1543 (Fed Cir. 1996), citing, *Chevron v. Natural Resources

Defense Council*, 467 U.S. 837 (1984). When agency rules either (a) depart from existing

practice or (b) impact the substantive rights and interests of the effected party, the rule

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[2]Accord Hoechst Aktiengesellschaft v. Quigg, 917 F.2d 522, 526, 16 U.S.P.Q.2d 1549, 1552 (Fed Cir. 1990);
Glaxo Operations UK Ltd. v. Quigg, 894 F.2d 392, 398-99, 13 U.S.P.Q.2d 1628, 1632-33 (Fed. Cir. 1990);
Ethicon Inc. v. Quigg, 849 F.2d 1422, 1425, 7 U.S.P.Q.2d 1152, 1154 (Fed. Cir 1988).

must be considered substantive. *Nat'l Ass'n of Home Health Agencies v. Scheiker*, 690 F.2d

932, 949 (D.C. Cir. 1982), *cert. denied*, 459 U.S. 1205 (1983).

    a.   **The PTO Requirement is Substantive Because it Radically Changes Long Existing Patent Practice by Creating a New Requirement Upon Applicants Outside the Scope of 37 C.F.R. § 1.78 (b)**

The Examiner's requirement is totally distinguishable from the well articulated

requirement authorized by 37 CFR § 1.78 (b), because it (1) creates and imposes a new

requirement to avoid abandonment of the application based on the allegation that

conflicts exist between claims of the related 328 co-pending applications, and (2) it

results in an effective final double patenting rejection without the PTO's affirmative

double patenting rejection of the claims. Long existing patent practice recognizes only

two types of double patenting, double patenting based on 35 U.S.C. § 101 (statutory

double patenting) and double patenting analogous to 35 U.S.C. § 103 (the well-known

obviousness type double patenting).[3] These two well established types of double

patenting use an objective standard to determine when they are appropriate[4] and have

a determinable result on the allowability of the pending claims.

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[3]MPEP § 804(B)(1) states, in an admittedly awkward fashion, that the inquiry for obviousness type double patenting is analogous to a rejection under 35 U.S.C. 103: "since the analysis employed in an obvious-type double patenting determination parallels the guidelines for a 35 U.S.C. 103 rejection, the factual inquires set forth in Graham v. John Deere Co., 383 U.S. 1, 148 U.S.P.Q. 459 (1966), that are applied for establishing a background for determining obviousness under 35 U.S.C. 103 are employed when making an obvious-type double patenting analysis".

[4] The objective test for same invention double patenting is whether one of the claims being compared could be literally infringed without literally infringing the other. The objective test for obviousness type double patenting is the same as the objective nonobviousness requirement of patentability with the difference that the disclosure of the first patent may not be used as prior art.

The Examiner's new requirement represents a radical departure from long existing patent practice relevant to conflicting claims between co-pending applications of the same inventive entity. Two well established double patenting standards are based on an objective analysis of comparing pending and *allowed* claims. However, in the present application, there are no *allowed* claims. The Examiner's new requirement to avoid a double patenting rejection presumes that conflicts exist between claims in the present application and claims in the 327 copending applications. This presumption of conflicts between claims represents a radical departure from long existing patent practice as defined by 37 C.F.R. § 1.78 (b), which states:

> Where two or more applications filed by the same applicant contain conflicting claims, elimination of such claims from all but one application may be required in the absence of good and sufficient reason for their retention during pendency in more than one application.

Clearly, the only requirement authorized by the rule is the elimination of conflicting claims from all but one application where claims have been determined to exist. Furthermore, in order to determine that conflicting claims do in fact exist in multiple applications, the only possible analysis is obviousness-type double patenting, since there are no allowed or issued claims by which to employ the 35 U.S.C. § 101 statutory double patenting analysis. Once obviousness-type double patenting analysis has been applied and conflicting claims have been determined to exist, only a *provisional* obviousness-type double patenting rejection is possible until claims from one application are allowed.

In summary, the Examiner's new requirement departs from long-established practice because it (1) creates and imposes a new requirement to avoid abandonment of the application based on the allegation that conflicts exist between claims of the related 328 co-pending applications, and (2) it results in an effective final double patenting rejection without the PTO's affirmative double patenting rejection of the claims.

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Therefore, the Examiner's new requirement departs from existing practice and therefore is a **substantive rule** beyond the authority of the PTO and is therefore, invalid.

> **b.** **The New Requirement is Also a Substantive Rule Because it Adversely Impacts the Rights and Interests of Applicants to Benefits of the Patent**

The rights and benefits of a U.S. patent is solely a statutory right. *Merck & Co., Inc. v. Kessler*, 80 F.3d 1543 (Fed Cir. 1996). The essential statutory right in a patent is the right to exclude others from making, using and selling the claimed invention during the term of the patent. Courts have recognized that sometimes new procedural rules of the PTO are actually substantive rules, e.g. when the new rule made a substantive difference in the ability of the applicant to claim his discovery. *Freesola v. Manbeck*, 36 U.S.P.Q.2d 1211, 1214 (D.D.C. 1995) (emphasis added), citing, *In re Pilkington*, 411 F.2d 1345, 1349; 162 U.S.P.Q. 145 (C.C.P.A. 1969); and *In re Steppan*, 394 F.2d 1013, 1019; 156 U.S.P.Q. 143 (C.C.P.A. 1967).

The new requirement, on its face and as applied here, is an instance of a PTO rule making a substantive difference in Applicants ability to claim their invention and, therefore, must be considered a substantive rule. The requirement denies Applicants rights and benefits expressly conferred by the patent statute. The measure of the value of these denied rights and benefits is that the requirement, as applied here, would deny Applicants the full and complete PTO examination of Applicants' claims on their merits, as specified by 37 C.F.R. § 1.105. In addition, to file terminal disclaimers in each of the related 328 applications terminally disclaiming each of the other 327 applications based on the PTO's incomplete examination on the merits would deny Applicants' the benefit of the full patent term of 17 years on each of Applicants' respective applications.

Applicants respectfully submit that the requirement has a huge impact on their rights and interests in the presently claimed invention.

c.   Conclusion: Substantive Rule

In summary, the requirement is a change to long existing practice and/or has a substantive impact on the rights and interests of Applicants to their invention. Either finding means that the new requirement is a substantive rule. Since the Commissioner has no power to issue substantive rules, the requirement is an improperly promulgated substantive rule having no force of law.

3.   The PTO Requirement is Outside the Scope of 37 C.F.R. § 1.78 (b)

Rule 78 (b) states that:

> Where two or more applications filed by the same applicant contain conflicting claims, elimination of such claims from all but one application may be required in the absence of good and sufficient reason for their retention during pendency in more than one application.

The only **requirement** that Rule 78 (b) authorizes is the elimination of conflicting claims from all but one co-pending applications.

In the instant Final Office Action, Examiner has not required the elimination of all conflicting claims from all but one application, but instead has required Applicants to: 1) file terminal disclaimers in each of the related 328 applications; 2) provide an affidavit; or 3) resolve all conflicts between claims in the related 328 applications. None of the options in the requirement is authorize by Rule 78 (b), and therefore Applicants respectfully submit that such a requirement is improper.

With respect to the PTO's authority to act within Rule 78 (b) regarding the rejection of conflicting claims, M.P.E.P § 822.01 states that:

> Under 37 CFR § 1.78 (b), the practice relative to overlapping claims in applications copending before the examiner..., is as follows: Where claims in one application are unpatentable over claims of another application of

the same inventive entity because they recite the same invention, *a complete examination should be made of the claims of each application* and all appropriate rejections should be entered in each application, including rejections based upon prior art. *The claims of each application may also be rejected on the grounds of provisional double patenting on the claims of the other application* whether or not any claims avoid the prior art. Where appropriate, the same prior art may be relied upon in each of the applications. MPEP 822.01 (6th Ed., Rev. 3, 1997), *(emphasis added)*.

In light of the requirement of the Final Office Action, M.P.E.P § 822.01 and 37 CFR § 1.78 (b) are not applicable since there has not been any rejection with regard to the elimination of conflicting claims from all but one co-pending application.

> 4.   The Assertion That Failure to Comply with the Requirement Will Result in Abandonment of Applicants' Application is Improper

Applicants' prospective failure to comply with the above requirements cannot properly result in abandonment of the present application. Applicants respectfully submit that abandonment of an application can properly occur only:

(1)   for failure to respond within a provided time period (under Rule 135);

(2)   as an express abandonment (under Rule 138); or

(3)   the result of failing to timely pay the issue fee (under Rule 316).

There is no provision in the rules permitting abandonment for failure to comply with any of the presented requirements. To impose an improper requirement upon Applicants and then hold the application is to be abandoned for failure to comply with the improper requirement violates the rules of practice before the USPTO. Furthermore, Examiner is in effect attempting to create a substantive rule which is above and beyond the rulemaking authority of the USPTO, and therefore is invalid.

In the *Application of Mott,* 539 F.2d 1291, 190 USPQ 536 (CCPA 1976), the applicant had conflicting claims in multiple applications. The CCPA held that action by Examiner which would result in automatic abandonment of the application was legally untenable. *Id.* at 1296, 190 USPQ at 541. In the present application, Examiner has

asserted that there are conflicting claims in multiple applications, and that non-compliance of the Final Office Action's requirement will result in an automatic abandonment. Therefore, under *Mott's* analysis, the Final Office Action's result of abandonment of Applicant's application is legally untenable.

5. Response to Apparent Conflict of Claims

Applicants submit that the presentation of the Final Office Action Appendix fails to demonstrate any conflicts between claims of the present application and claims of the co-pending applications. Rather, the Final Office Action Appendix compares representative claims of *other* applications in attempt to establish that "conflicting claims exist between the 328 related co-pending applications." Absent any evidence of conflicting claims between the Applicants' present application and any other of Applicants' co-pending applications, any requirement imposed upon Applicants to resolve such alleged conflicts is improper.

6. Request for Withdrawal of Requirement

Therefore, Applicants respectfully request that Examiner reconsider and withdraw the requirement that Applicants: (1) file terminal disclaimers in each of the related 328 applications terminally disclaiming each of the other 327 applications; (2) provide an affidavit attesting to the fact that all claims in the 328 applications have been reviewed by applicant and that no conflicting claims exist between the applications; or (3) resolve all conflicts between claims in the above identified 328 applications by identifying how all the claims in the instant application are distinct and separate inventions from all the claims in the above identified 328 applications, which upon failing to do so will abandon the application.

7.   Filing of Supplemental Oath

Notwithstanding the foregoing, Applicants will file a supplemental oath under 37 C.F.R. § 1.67 for each application when Examiner identifies allowable subject matter. Applicants respectfully propose that the filing of individual supplemental oaths attesting to the absence of claim conflicts between previously patented claims and subsequently allowed claims is a more reasonable method of ensuring the patentable distinctness of subsequently allowed claims.

Under 37 C.F.R. § 1.105, § 1.106 & § 1.78 (b), Examiner has the duty to make every applicable rejection, including double patenting rejection. Failure to make every proper rejection denies Applicants all rights and benefits related thereto, e.g., Applicants' right to appeal, etc. Once obviousness-type double patenting analysis has been applied and conflicting claims have been determined to exist, only a *provisional* obviousness-type double patenting rejection is possible until claims from one application are allowed.

C.   Information Disclosure Statement

The Applicants appreciate the Examiner's review of the Information Disclosure Statements filed December 8, 1995, December 15, 1995, February 6, 1996, and April 17, 1996, and have addressed those specific concerns raised in the office action. It is the Applicants' understanding that the Examiner raised the following 5 issues:

(1)   the reasons for such a large number of references cited,

(2)   foreign language references cited without a statement of relevance or translation have not been considered,

(3)   the relevancy of numerous references listed in the Information Disclosure Statements are subsequent to the Applicants' latest effective filing date of September 11, 1987,

(4)   citation of references apparently unrelated to the subject matter of the claimed invention, and

(5)   citation of database search results listed in foreign languages where no copy was provided.

1.   Reason for Citation of Large Number of References

The reason that the Applicants submitted such a large number of references in the Information Disclosure Statements was that a large portion of the information cited by the Applicants was brought to the Applicants' attention in the discovery processes in a previous litigation in the United States District Court for the Eastern District of Virginia (*Personalized Mass Media Corp. v. The Weather Channel, Inc.* Docket No. 2:95 cv 242) and an investigation by the International Trade Commission (*In the Matter of Certain Digital Satellite System (DSS) Receivers And Components Thereof,* No. 337 TA 392, which was direct to U.S. Pat. No. 5,335,277) regarding claims in the Applicants' related issued patents. The documents listed in the Information Disclosure Statement were cited during the previous litigation/investigative proceedings by the alleged infringers in the aforementioned proceedings as being relevant and material to patentability of the claims in the related patents. The Applicants submitted those materials in the Information Disclosure Statement to the PTO at the earliest possible time in order to file them in compliance with the 3 month requirement stated in the certification used to submit the Information Disclosure Statement before the Final Office Action was issued as is necessary under 37 CFR § 1.97 (c) (1). In such haste, entries were inadvertently submitted which do not appear on their face to be material to the patentability of the present application.   Applicants have corrected this error with the submission of the corrected Information Disclosure Statement as shown in Appendix B. However, it is the Applicants' understanding that not all references cited must be material to patentability in order for such references to be considered. In § 609 of the MPEP, it states,

> "[t]hese individuals also may want the Office to consider information for a variety of reasons: e.g., without first determining whether the information meets any particular standard of materiality, or because another patent

office considered the information to be relevant in a counterpart or related patent application filed in another country, or to make sure that the examiner has an opportunity to consider the same information that was considered by the individuals that were substantially involved in the preparation or prosecution of a patent application."

Applicants' position is that information that was considered material in previous litigation would fall into the 'variety of reasons' category as stated above. Applicants intention was not to confuse or make difficult the examination process for the Examiner, but was instead to be forthright and open in disclosing all information deemed to be relevant to the application in issue by third parties.

2. Citations of Foreign Language References

Applicants have re-examined the foreign references listed in all of the Information Disclosure Statements and have either eliminated such references from the list, included translations herewith or provided statements as to the relevancy of such references (APPENDIX A). The inclusion of translations with this response is in compliance with 37 C.F.R. § 1.97 (f) which states in part, "[I]if a bona fide attempt is made to comply with 37 C.F.R. § 1.98, but part of the required content is inadvertently omitted, additional time may be given to enable full compliance." The omission of any translations and/or relevancy statements for foreign references were inadvertent and unintentional and are herein submitted in accordance with 37 C.F.R. § 1.97 (f).

3. References in the Information Disclosure Statements Subsequent to Applicants' Latest Effective Filing Date of 9/11/87

Examiner stated "[n]umerous references listed in the IDS are subsequent to the applicant's latest effective filing date of 9/11/87, therefore, the relevancy of those references is unclear." Upon further examination, the Applicants have eliminated those patents and publications after the effective filing date for the present application. It is

the Applicants' understanding that the effective for the present application is September 11, 1987.

4. Citation of Unrelated References

Applicants appreciate the Examiner pointing out such references that were listed yet on their face appear to be unrelated to the subject matter of the present application. In response to such information, the Applicants have reviewed the cited references and removed any such references which appear to be unrelated on their face to the claimed subject matter such as the patent for a beehive, the patent for a chemical compound and numerous computer printout search results.

5. Citation of Database Search Results

Database search results listed in foreign languages where no copy was provided have been eliminated from the substitute Information Disclosure Statement included with this office action.

The Applicants' offer the corrected Information Disclosure Statement (APPENDIX B) as a substitute to the previously filed Information Disclosure Statement filed 4/17/97. No new entries have been entered, only citations which have, upon further examination, been determined not to be relevant to the claimed subject matter have been eliminated, typographical errors have been corrected, dates inserted where possible and the list shortened as a result. It is the Applicants' intention that such corrected Information Disclosure Statement will help clarify any issues previously raised by the Examiner and aid in the prosecution of the present patent application.

D. Response to Rejections under 35 U.S.C. § 112

1. Specification Support of Claims 5-34

Paragraph 6 of the Final Office Action rejects claims 5-34 under 35 U.S.C. § 112, first paragraph, as containing subject matter which was not described in the

specification in such a way as to reasonably convey to one skilled in the relevant that the inventors, at the time the application was filed, had possession of the claimed invention. The Final Office Action specified a large portion of the language recited in claims 5-34 as allegedly not being supported by the specification as originally filed.

Applicants' claimed invention is generally disclosed at the following places in the specification: page 120, line 24 through page 125, line 9, page 452, line 24 through page 470, generally.

The following tables list Applicants' claim language in the left column which corresponds to the specification support in the right column.

a.   **Claim 5**

receiving an information transmission containing processor instruction and a program	For example, at page 470, line 1 through page 471, line 2, page 478, lines 23-26, page 484, lines 7-18, and page 354 through 390.
programming said receiver station to perform a secondary error correction routine in accordance with said processor instructions	For example, page 484, lines 7-18, page 506, lines 13-21, and page 515, line 9 through page 516, line 13,

b.   **Claim 6**

clearing at least a portion of said memory	For example, page 515, line 34.

c.   **Claim 7**

one of placing and replacing data at said memory to one of complete and correct ...	For example, page 516, lines 2-5

d.   **Claim 23**

receiving an information transmission ... containing only a portion of processor instruction and a program	For example, page 356, line 24 through page 358, line 9 and page 356, lines 26-32.
generating the remainder of said processor instructions and said program	For example, page 358, lines 1-21, page 360, line 2 through page 365, line 21.
transmitting said information transmission containing said program and said processor instructions	For example, page 367, lines 25-27, page 371, line 11 through page 372, line 6, and page 372, lines 20-35.
wherein said program programs said receiver station ... instructions	For example, page 484, lines 7-18.
wherein said processor instructions ... transmission	For example, page 157, lines 2-5, page 233, line 21 through page 234, line 28 and page 452, line 30 through page 453, line 1.
to discern a failure evidencing ... transmission	For example, page 234, line 29 through page 235, line 20, page 233, line 21 through page 234, line 28 and page 452, line 20 through page 453, line 1.
and to execute a predetermined secondary error .. failure	For example, page 515, line 9 through page 516, line 13 and page 452, line 30 through page 457, line 10.

e.   **Claim 24**

effects a transmission station to generate a program	For example, page 358, lines 1-21 and page 360, line 2 through page 365, line 21.
said receiver station to perform ... transmission	For example, page 157, lines 2-5, page 233, line 21 through page 234, line 28 and page 452, line 30 through page 453, line 1.
to discern a failure evidencing ... transmission	For example, page 234, line 29 through page 235, line 20, page 233, line 21 through page 234, line 28 and page 452, line 30 through page 453, line 1.
to execute a predetermined secondary error correction routine ... failure	For example, page 515, line 9 through page 516, line 13 and page 452, line 30 through page 457, line 10.
effects said receiver station ...	For example, Fig. 6, page 346, line 34 through page 347, line 5, page 357, lines 1-35, and page 359, lines 17-19.

to generate a program	For example, page 358, lines 1-21 and page 360, line 2 through page 365, line 21.
said receiver station to perform ... transmission	For example, page 147, lines 2-5, page 233, line 21 through page 234, line 28 and page 452, line 30 through page 453, line 1

f.   **Claim 25**

receiving an information transmission containing mass medium programming including audio programming	For example, page 470, lines 1 through page 471, line 2 and page 478, lines 23-26
performing a primary error correction routine	For example, page 157, lines 2-5.
passing information ... memory	For example, page 488, lines 24-27.
discerning a failure ... transmission	For example, page 515, lines 2-9, page 233, line 21 through page 235, line 20 and page 452, line 30 through page 453, line 1.
executing a predetermined secondary error correction routine ...	For example, page 515, line 1 through page 516, line 13, page 233, line 21 through page 235, line 20 and page 452, line 30 through page 453, line 1.

g.   **Claim 26**

Generally	Page 515, lines 5-9, page 493, line 34 through page 494, line 8 and page 453, lines 8-24.

h.   **Claim 27**

receiving an information transmission containing ...	For example, at page 470, line 1 through page 471, line 2, page 478, lines 23-26, page 482, line 32 thorugh page 483, line 2, page 484, lines 7-18, page 354 through 390, and page 490, line 23 through page 492, line 19.
performing a primary error ...	For example, page 157, lines 2-5
passing information .. to said memory	For example, page 488, lines 24-27

discerning a failure ... transmission	For example, page 515, lines 2-9
executing a predetermined secondary error	For example, page 515, line 1 through page 516, line 13, page 233, line 21 through page 235, line 20 and page 452, line 30 through page 453, line 1.

i.   **Claim 28**

receiving an information transmission containing ...	For example, at page 470, line 1 through page 471, line 2, page 478, lines 23-26, page 482, line 32 through page 483, line 2, page 484, lines 7-18, page 354 through 390, and page 490, line 23 through page 492, line 19.
performing a primary error ...	For example, page 157, lines 2-5
passing information .. to said memory	For example, page 488, lines 24-27
discerning a failure ... transmission	For example, page 515, lines 2-9
selecting one of a plurality of predetermined secondary error correction routines	For example, page 515, lines 5-9, page 453, line 1 through 456, line 26.
executing a predetermined secondary error	For example, page 515, line 1 through page 516, line 13, page 233, line 21 through page 235, line 20 and page 452, line 30 through page 453, line 1.

j.   **Claim 29**

receiving an information transmission containing ...	For example, at page 470, line 1 through page 471, line 2, page 478, lines 23-26, page 482, line 32 through page 483, line 2, page 484, lines 7-18, page 354 through 390, and page 490, line 23 through page 492, line 19.
performing a primary error ...	For example, page 157, lines 2-5
passing information .. to said memory	For example, page 488, lines 24-27
discerning a failure ... transmission	For example, page 515, lines 2-9
executing a predetermined secondary error	For example, page 515, line 1 through page 516, line 13, page 233, line 21 through page 235, line 20 and page 452, line 30 through page 453, line 1.

k.   **Claim 30**

receiving an information transmission containing mass medium programming including audio programming	For example, page 470, lines 1 through page 471, line 2 and page 478, lines 23-26
programming said receiver station ...	For example, page 484, lines 7-18, page 515, lines 5-9, page 453, line 1 through page 456, line 26.
performing a primary error correction routine	For example, page 157, lines 2-5.
passing information ... memory	For example, page 488, lines 24-27.
discerning a failure ... transmission	For example, page 515, lines 2-9, page 233, line 21 through page 235, line 20 and page 452, line 30 through page 453, line 1.
executing a predetermined secondary error correction routine ...	For example, page 515, line 1 through page 516, line 13, page 233, line 21 through page 235, line 20 and page 452, line 30 through page 453, line 1.

l.   **Claim 31**

Generally	For example, page 486, lines 23-27 and page 495, lines 21-30.

m.   **Claim 32**

Generally	For example, page 486, lines 23-27 and page 495, lines 21-30.

n.   **Claim 33**

Generally	For example, page 90, lines 17-20, page 121, lines 13-18, page 122, line 34 through page 123, line 15, page 123, line 30 through page 124, line 30 and page 106, lines 24-33.

o.   **Claim 34**